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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/526,602	03/16/00	SUDA	Y 54490-Z/JPW/

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IM22/0807

EXAMINER

RODEE, C

ART UNIT	PAPER NUMBER
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1753

DATE MAILED:

08/07/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Advisory Action**

Appli cation No.

09/526,602

Applicant(s)

SUDA ET AL.

Examiner

Christopher D RoDee

Art Unit

1753

--The MAILING DATE of this communication appears on the cov r sheet with the correspondence address --

THE REPLY FILED 30 July 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 21-27.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: See Continuation Sheet.

  
**CHRISTOPHER RODEE**  
**PRIMARY EXAMINER**

009/526,602

Continuation of 2. NOTE: the proposed amendment to independent claim 21 requires further search and consideration and raises the issue of new matter because the claim now specifies that heating occurs after the steps of dispersing and mixing while stirring. This order of steps was not previously presented and does not appear to have basis in the specification as filed. Further, the claim as proposed is indefinite because it is unclear if the dispersing and mixing steps are actually required steps in the process. The process only recites these steps in reference to the timing of the heating step, but they are not positively recited as occurring in the process.

Continuation of 5. does NOT place the application in condition for allowance because: the size of the precipitated particles in Hou would be a result of the solubility parameters of the solvent and resin and other process conditions, such as heating, mixing, and cooling characteristics. The reference, viewed from the perspective of the skilled artisan, would understand that the process variables control the size, shape, and other characteristics of the particles. The claims are not limited to particles having a size of 2 to 3 mm as specified in the remarks. Sato reasonably suggests the addition of silica and titanium oxide to the liquid toner of Hou. The reason for addition of these particles to Hou does not need to be the same as the reasons used by applicant.

Continuation of 10. Other: The amendments to claims 22 and 23 would be entered if submitted separately and would overcome the section 112, second paragraph, rejections for these claims..